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03-23-02

EXAMINER: WILLMON FRIDIE JR.

703.305.3579

Application: 09/096,483 ✓
Filed: 06/10/98
Applicant: David C. Schwartz
Docket: ADLEAF
Examiner: Fridie, Jr. W
Art Unit: 3722



Honorable Commissioner of
Patents and Trademarks

Response to Office Action

This paper is a response to the office action of 10/23/01. The response filed in the second month of extension, so a two month extension fee of \$200.00 is filed herewith using the credit card payment procedure.

The Examiner examined the claims 1-42 filed with the case and rejected the claims. In the detailed action, the Examiner noted:

- 1.-- that a proper assent of assignee in compliance with 37 CFR 1.172 and 3.73 is required. Examiner requested those papers be submitted for this case.
- 2.-- that an appropriate paper satisfying 37 CFR 3.73 must be submitted.
- 3.-- The requirement under 37 CFR 1.56 to timely apprise of litigation involving 5,524,998 material to the patentability of the claims under consideration was pointed out by the Examiner.
4. Examiner has required that the applicant rewrite the amended claims on a separate sheet of paper incorporating all of the proposed changes, and the amended section of column 13 of the specification should be placed on a separate page.

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5. The reissue oath/declaration filed with the application is defective because it fails to contain a statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant (pursuant to 37 CFR 1.175 and MPEP §1414.

6. The reissue oath/declaration filed with the application is defective because it fails to contain the statement required under 37 CFR(a)(1) as to the applicant's belief that the original patent is wholly or partly inoperative(pursuant to 37 CFR 1.175(a)(1) and MPEP 1414.

7. The reissue oath/declaration filed is defective because:

- a. The individual inventor must be identified
- b. State sole
- c. Statement of review
- d. Original inventor
- e. The typed section of the declaration was confusing

8. The claims are being rejected as being based on a defective reissue declaration 35 USC 251 as set forth above(pursuant to 37 CFR 1.175) and the nature of the defects in the declaration are set forth. The examine provided a standard copy of a reissue oath and the applicant was encouraged to make any additional edits on the back side of page one if that form was used.

APPLICANTS RESPONSE:

1/2. The Applicant has attached hereto the proper assent by providing a signed paper in the name of the Applicant as the actual sole patent applicant, and as the owner and responsible officer of the company for acting on behalf of the company to which the patents are assigned, a list of the recorded assignments, and copies of the notice of recordings of assignment.

3. A statement under 37 CFR 1.56 regarding the status of no litigation in this case.

4. Rewritten amended claims on a separate sheet of paper and the amended section of column 13 on a separate page.

5/6/7. The Reissue Oath/Declaration has been replaced with a proper Reissue Oath/Declaration correcting all the defective points raised by the Examiner in sections 5/6/7.

8. The Applicant, in light of the submissions stated above in response points 1-7 respectfully traverses the rejection of the claims in Examiner point 8, on the basis that the corrections to the amendment have been properly filed and that the defective element of the Reissue Oath/Declaration have been corrected in the papers submitted herewith.

Statement under 37 CFR 3.73 of Inventor identification, Assignee identification, designation to Assignee with reference to assignment records, and Assignee statement of authorization to act in this reissue case, along with offer to surrender original ribboned letters patent.

Applicant, David C. Schwartz, of 55 Flagg Road Southboro MA 01772 is the original sole inventor of the above referenced patent application, 09/096,483 as well as each of the patents in the family tree there of as identified in the list of patents attached hereto and the copies of each of the assignment records thereof, and in each instance of each patent, has assigned said each patent or patent application to Productive Environments, Inc. , now of 945 Concord Street, Framingham Ma 01701. Applicant hereby affirms that he, David C. Schwartz, is the Chief Executive Officer of said Productive Environments, and is the officer with sole responsibility for making statements which legally bind Productive Environments. In this capacity, as officer of the assignee, David C. Schwartz and Productive Environments authorize the Patent Office to take any action necessary in response to this reissue application, and respectfully request that the case be reissued as amended and allowed to publish in due course as a replacement for the original issued patent.

Further, Productive Environments , shall upon request surrender the original ribboned issued letters patent 5,524,998 issued June 11, 1996 in the interest of receiving a replacement patent amended as proposed in the papers on file and as provided here in response to the office action of 10/23/01.

Proper Assent of Assignee

The following is a list of the assent of the assignee showing that each patent application had a sole inventor, David C. Schwartz, and the David C. Schwartz assigned said patent applications to Productive Environments, Inc.

Serial # 7-963097

Recording date 03/01/93 4 pages on reel/frame 6433/0512

Serial # 8-019645

Recording date 02/18/93 3 pages on reel/frame 6447/0269

Serial # 8-193381

Recording date 02/08/94 6 pages on reel/frame 7044/0938

Serial # 9-096483

Recording date 04/15/99 2 pages on reel/frame 9890/0799

The actual copies (8 pages) of the assignment papers of which are attached here to as "assignment trail".

Statement under 37 CFR 1.56

At this time, Applicant knows of no litigation regarding 5,524,998 in its current state nor in its proposed amended state of claims, and Applicant understands that it is his obligation to make a timely notification to the Patent Office of any litigation material to the patentability of the claims under consideration.

Reference to the amended claims and specification

The Examiner has requested that the Applicant submit the amended claims on a separate sheet of paper along with the change to column 13. Included herewith is a complete replacement specification in double column showing exactly where the column 13 amendment is made and exactly where the claim is amended, in addition to providing each of the column 13 and amended claims on separate sheets of paper. Further, a single column per page substitute specification showing the amended column 13 and the amended claim as originally submitted in the first papers from the applicant are also included herewith.

Replacement reissue oath/declaration

A proper replacement reissue oath/declaration is included which corrects the errors pointed out by the examiner in the OA of 10/23/01.

Applicant respectfully requests that this response be considered in due course, that the traversal of the rejection of the claims be accepted, that the amendment to the specification and the claims be approved, and that the case be approved for publication as a reissue case as amended.

Respectfully,

A large, stylized handwritten signature in black ink, appearing to read 'David C. Schwartz'.

3/21/02

David C. Schwartz
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HP OfficeJet G Series G85
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Fax-History Report for
ProductiveEnvironmentsInc.rÒ Ú n Ú T
508-460-9277
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